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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,310	12/18/2001	David Ross Mathog		8215

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David Ross Mathog
1215 Greenfield Avenue
Arcadia, CA 91006

EXAMINER

ONEILL, MICHAEL W

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,310

Applicant(s)

MATHOG, DAVID ROSS

Examiner

Michael O'Neill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 11 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 11 and 22-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Response to Amendment

The amendment to the specification filed on 1-7-5 does not comply with the requirements of 37 CFR 1.121 because the amendment does not direct the Office immediately above said amendment where to particularly insert the paragraph to replace. Applicant needs to resubmit the amendments to the specification and identification the location of the amendment immediately prior to the amendment itself.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 and those that depend therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2 the following two limitations are indefinite because it is unclear what tangible structure this limitations represent: "at least one binary variable, said variable(s) encoding the device states" and "a time varying value, the current device state, encoded by the binary variable(s)." Both

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of these limitations seem to be claiming variables and time and not tangible structures, such as the latter four limitations are drafted to recite. Variables can be claimed when defined, e.g. "a display matrix having $m \times n$ rows and columns where m and n are intergers starting with the value of 2".

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejections of claims 2-4, 11 and 22-36 under 35 U.S.C. § 103(a) as being unpatentable over Karrenberg is maintained from the previous Office action on the merits dated 6-8-04 and incorporated herein.

Response to Arguments

Applicant's arguments filed 1-7-05 have been fully considered but they are not persuasive.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the present device produces an uncertainty - the athlete cannot predict, except statistically, what the environmental state signaled by the device will be at some future time; the present device will only asymptotically approach that mean time over a long period and will have a large variance in the duration of

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each state; to configure the present device, one must specify: the minimum hold time for a device state, the means transition frequency, whether transitions are periodic or random, the transition order (random or sequential), and the average time spent in each device state (via the occupancy values); the present device would generally be configured so that the next state could not be predicted (except statistically, like the weather); in neither case would random variations from the specified time intervals be consistent with the desired training objection; in the present device the switches are indeed read by a controller, and those values which are read are used within a program executed by that controller; the environmental states explicitly described in the present application are more varied, change more quickly and typically refer to changes in direction or a choice of different actions) are not recited in the rejected claim(s), specifically claim 2 where the remarks are being utilized to promote patentability of the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Karrenberg's device is for states, levels or conditions of exertion whereas the present invention is for states or conditions that are more varied, change more quickly and typically refer to changes in direction or a choice of different actions, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is

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largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

The following claim roughly drafted by the examiner and is considered to distinguish itself patentably over the art of record in this application; however, another search would need to be conducted and support therefor and definiteness would need to be further addressed vis-a-vis the originally filed disclosure, claim is presented to Applicant for consideration and amending to better reflect the operation of the components that constitute the claimed invention (the Examiner just listed the components and tried to provide the necessary structural and cooperational relationships, as examples, that are needed for claims in order to particularly point out and distinctly claimed their respective subject matter):

An apparatus for assisting in the application of soccer drills comprising:

a contrasting colored plastic cone;

a ring of red LEDs mounted near the tip of the cone;

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a ring of blue LEDs mounted near the middle of the cone;

an electronic controller with an internal read only memory;

a power switch;

a frequency dial for setting the mean frequency between the range of 600 transitions per minute to 0.1 transitions per minute at which the controller may apply power to the LEDs;

a hold time dial for setting the amount of time between the range of 200 milliseconds and 5 minutes at which the apparatus ;

a pair of eight position DIP switches, wherein one of the dual in-line package switches sets whether transitions are periodic or random, one of the dual in-line package switches sets whether the order is sequential or random, and twelve of the dual in-line package switches set one of the four following lighted states for the LEDs: red LEDs off, blue LEDs off; red LEDs lit, blue LEDs off; red LEDs off, blue LEDs lit; or red LEDs lit, blue LEDs lit; and

a removable battery providing power to the LEDs, the controller;

wherein when power is applied via said power switch and at one second intervals thereafter, the controller reads the settings from said frequency dial and said hold time dial and for said pair of DIP switches and using said controller's internal program and the setting information from said dials

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driving the red and blue sets of LEDs for the desired soccer drilling application.

As demonstrated above, inventions are claimed by what constitutes elements and how those elements interact; and not by, intended usage and functionality. The Examiner tried to draft the claim to reflect the following disclosure by Applicant: "When used in the soccer dribbling drill application a typical setting might be: random transitions with a mean frequency of 15 transitions per minute, a minimum hold time of .5 seconds, random transition order, and occupancies set to 2,7,7,2" (i.e. 20 percent in state 0 which is both rings of LEDs off; 70 percent in state 1 which is red rings lit and blue rings off; 70 percent in state 2 which is red rings off and blue rings on; and 20 percent in state 3 which is red rings lit and blue rings lit).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 571-272-4442. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'M O'Neill', is written above the printed name.

**MICHAEL O'NEILL
PRIMARY EXAMINER**